

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the consideration given the present application, and for the personal interview conducted on June 30, 2004. The application has been carefully reviewed in light of the Office action and the interview, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

At the personal interview, it was discussed in detail that the art of record does not teach any phase shifter that *inputs* a band switching signal. The Examiner agreed that such a feature was not shown in Figure 12 of the application, which was cited as admitted prior art by the Examiner.

Claims 1-30 remain in this application.

The Examiner has allowed claims 7-10, 17-21, and 30.

The Examiner objected to claim 29 for formalities that are corrected by the amendment provided in this response. Hence, this objection is moot.

The Examiner objected to claims 4-6, 14-16, 23-24, 26-27 and 29 as being dependent on a rejected parent claim, but allowable if put into independent format. Because applicant is traversing the rejection of the parent claim, these claims are not being put into independent format. The objections will be moot upon allowance of the parent claims.

Claims 1-2, 11-12, 25, and 28 were rejected under 35 U.S.C. §102(a) as being anticipated by admitted prior art. Claims 3, 13, and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over admitted prior art in view of Otaka (U.S. 6,148,181) For the following reasons, the rejections are respectfully traversed.

Claim 1, as amended, recites a "multiband data communication apparatus" which receives signals by "switching a plurality of frequency bands in response to a *band switching signal*", with the apparatus comprising "phase shifting means for *inputting* said band switching signal..." (emphasis added). Claims 11 and 22 have been amended to recite similar limitations.

The Examiner cites Figure 12 of the application as being admitted prior art, and as teaching claim 1. However, even if figure 12 is considered prior art, the figure, along with its accompanying text, does not show any phase shifting means *inputting* a band switching signal,

as was discussed at the personal interview. The Examiner cites input 153 as being a "band switching signal". However, even if so considered, there is no teaching that the signal 153 is *input* to the phase shifters shown in the figure. In fact, it is clear from the diagram that the phase shifting is not based upon anything at all, but is instead always performed (note that the output of oscillators 111, 611, are continuously input into shifters 1209, 1219, whose outputs are continuously input into mixers 109, 110 and 609, 610, respectively), as discussed at the interview. Contrast this with figure 1 of the application, which shows signal 153, decoded by DEC 107, operating on switch 114, which then determines the phase shift of the signal being input to mixer 110, which was also discussed at the interview.

Consequently, for at least the above reasons, claim 1 is patentable over Fig 12. Claims 11 and 22 are thus also patentable over figure 12. Because the Otaka reference does not overcome the shortcomings of Fig. 12, the remaining claims are also patentable over the combination of Fig. 12 with Otaka.

Further, the Examiner has not provided the proper motivation for modifying figure 12 according to Otaka. The Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references can be modified, alone, is not sufficient to establish *prima facie* obviousness (Id.). The prior art must also suggest the *desirability* of the combination (Id.). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is also not sufficient, by itself, to establish *prima facie* obviousness (Id.).

The Examiner has cited no support for any such suggestion or motivation for the modification from within Otaka, and the examiner clearly cannot rely on the application, because that would apply improper hindsight motivation. Accordingly, Otaka is not properly combined with figure 12.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is encouraged to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

Appl. No. 09/535,303
Amdt. Dated July 28, 2004
Reply to Office action of April 8, 2004

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32430.

Respectfully submitted,

PEARNE & GORDON, LLP

By:


Robert F. Bodi, Reg. No. 48,540

1801 East 9th Street, Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

July 28, 2004